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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,057	09/25/2000	Bruce Brumberg	BRUM-101	2821
7590 Robert K Tendler 65 Atlantic Avenue Boston, MA 02110		08/24/2007	EXAMINER PATEL, JAGDISH	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 08/24/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/669,057	<b>Applicant(s)</b> BRUMBERG, BRUCE	
	<b>Examiner</b> JAGDISH PATEL	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. This communication is in response to amendment filed 8/13/07.

### ***Response to Amendment***

2. Claims 1-16 have been cancelled. Restriction of previously added new claims 20-22 has been withdrawn. This office action is thus responsive to the amendment filed responsive to the final rejection issued on 6/21/07 and issued as a new Final Rejection. The examiner has issued this rejection to address defects of the pending claims 20-22 as described herein.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 20-22 are indefinite and unclear because there is no recitation of how the two cases of (1) immediately exercising the stock option and (2) waiting exercise the stock option to the end of the term of the stock option depend upon the annual percentage increase in the alternate investment value. Furthermore, the calculating step refers to "overall gain by individual grant" (interpreted to read stock options awarded to the employee) as based upon "inputted percentage increase for the stock price and the inputted increase for the alternative investment"

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without defining any step that specify the dependence of the overall gain on the alternate investment for the stated two cases.

5. The claims are also further rendered unclear because the annual percentage increase in the stock price and the annual percentage increase in the alternative investment value are specified vaguely. Are these just some arbitrary or hypothetical numbers specified by a user? Are they based upon past performance of the stock and the alternative investment? Or Are they based upon the estimated future performance of the stock and the investment? Can these numbers be relied upon to make decisions for the exercise of the stock options? The examiner has interpreted these inputs to be arbitrary number based upon pure human consideration.

6. The claims are also indefinite because case (1) would require that the stock options have no restriction of time limit. If the vesting schedule does not permit immediate exercise of the stock option, it is not practical to even contemplate immediately exercising the stock option. The claim fails to specify any terms relevant to the stock option vesting to determine the gains for the two cases. For example, if the stock option is immediately exercised (and converted to the company stock), how the gain is to be determined on basis of the percentage increase in the company stock without the cost basis of the stock options?

7. Appropriate corrections are required to resolve the aforementioned deficiencies.

### ***Claim Rejections - 35 USC § 101***

8. Claims 20-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim(s) fail to produce useful, concrete and tangible result as required under 35 U.S.C. 101. The claimed invention recites comparing two gains recited as based upon (1) immediately exercising the stock option and (2) waiting to exercise the stock

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option until closer to the end of the term of the stock option. The determination the two gains depend among other parameters inputting an annual percentage increase in the company stock price and an annual percentage increase in an alternative investment. The claim fails to provide any basis for these inputs (such as projections of the future growth, past performance etc.).

Furthermore, the claimed invention fails to provide any specific manner in which these parameters are applied in the calculation of the overall gain. The “useful” prong of the statutory requirement dictate that the claimed invention as a whole must satisfy the utility requirement of 101. The utility must be specific, substantial, and credible utility. Since, the claim fails to specify at least how the inputted percentage increase in the alternate investment value can effect the overall gain by the stock option grant, the calculated gains lack credible and specific utility and thus fails the “useful” prong of the test.

9. In summary, the claimed invention fails to produce useful result that meet the aforementioned standard and therefore deemed non-statutory under 35 USC § 101.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

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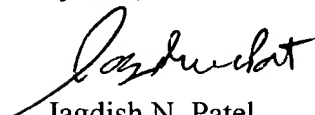
the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

8/19/07